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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,809	05/02/2007	James Vanerd Wicklund JR.	0671-0106PUS2	5361

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EXAMINER
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PATEL, BHARAT C

ART UNIT	PAPER NUMBER
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3724

NOTIFICATION DATE	DELIVERY MODE
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02/02/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/563,809	<b>Applicant(s)</b> WICKLUND, JAMES VANERD	
	<b>Examiner</b> BHARAT C. PATEL	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 3-10 and 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/3/07</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of subgroup "a", claims 1-2 and 11-12, in the reply filed on 12/24/08 is acknowledged. The traversal is on the ground(s) that the dependent claims are not properly restricted. This is not found persuasive because the search for each individual invention may overlap with other invention, but they do not coincide identically throughout. It should be noted that the examiner search different classes/subclasses for each individual invention for a particular group. For example, a cylindrical pin with a flat side of claim 2 is unique compare to the cylindrical pin with two flat surfaces of claim 3, as both of them represent unique function requiring search in different classes including text search. Similarly, a cylindrical pin with a flat side positioned 90 degree angle relative to a cutting edge of claim 2 is the same as a pin including a flat side positioned 90 degree angle relative to a cutting edge of claim 12 representing the same invention requiring search in the same class/subclasses.

The requirement is still deemed proper and is therefore made FINAL.

Claims 3-10 and 13-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected subgroups b-h, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/24/08.

### ***Specification***

2. The disclosure is objected to because of the following informalities:

In line 10, page 6 of specification, “the engaging portion 156” is believed to be in error for -- the engaging portion 16 --.

The claimed subject matter of “a locking portion” in lines 8-9 of claim 11 is not clearly disclosed in the specification or in the drawings.

Appropriate correction is required.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “locking portion” as claimed in claim 11, lines 8-9 of claim 11, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a) because they fail to show “224, 226 and 232” as described in lines 10, 10 and 13 respectively of the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claimed subject matter of “a cylindrical pin with a flat side positioned at a 90 degree angle to a cutting edge of a power tool” in claim 2 is not clearly and specifically disclosed in the specifications or the drawings of Figs. 1-16. Also, the claimed subject matter of “a locking portion” in claim 11 is not clearly and specifically disclosed in the specification or the drawings. Also, the use of “a power tool”, “an article” and “a cutting edge” repeatedly in multiple claims, it is not clear that the Applicant is distinctly relating the invention to a specific power tool or there are different power tools for different independent or dependent claims. Therefore, the claimed subject matters in claims 1-19 render indefinite and unspecific.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2 and 11-12, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Selander 3,284,895.

Re claim 1, Selandar discloses a clamping tool “K” for use with a power tool as a saber saw comprising: a housing “U” adapted to be mounted on a power tool per Fig. 5,

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said housing including at least one engaging portion, as parallel supporting walls 27; a locking pliers "K" having a retaining section 28 with a proximal end nearby 29 and a distal end at near by "P", said proximal end being adapted to be selectively mounted on the at least one engaging portion 27 to selectively retain the locking pliers "K" in a movable relationship relative to the housing "U"; and an engaging section, as jaw portion of "P", of said locking pliers "K" being mounted relative to the retaining section 28 for selectively being locked relative to the distal end at nearby "P" of the retaining section 28 for positioning an article "N" therebetween per Figs. 5-6; wherein when an article "N" is locked relative to the distal end at nearby "P" of the retaining section 28 and the engaging section, as jaw portion of "P", of the locking pliers "K", the proximal end nearby 29 of said retaining section 28 can be rotated relative to the housing to permit a power tool to come into engagement with an article. It should be noted that the Examiner interprets parallel supporting walls 27 of the housing "U" as an engaging portion which is engaging the locking pliers to the housing.

Re claim 2, Selandar discloses a cylindrical pin 29 with a fiat side positioned at a 90° angle relative to a cutting edge 31 of a power tool for preventing disengagement of the locking pliers during a cutting operation. It should be noted that the flat plane of the top tangential line of the pin surface is at 90 degree angle to a cutting edge. It should also be noted that the Applicant has not clearly and distinctly disclosed the cylindrical pin in Figs. 1-16, and the related disclosure of the species represented by Figs. 1-16. Therefore, examiner considers that Selandar satisfies the claimed subject matter.

Re claim 11, Selandar discloses a housing "U" adapted to be mounted on a power tool, said housing including at least one engaging portion as supporting walls 27 of a bracket "V"; a locking pliers "K" having a retaining section 28 with a distal end as portion near 29, said distal end being adapted to be selectively mounted on the at least one engaging portion to selectively retain the locking pliers "K" in a movable relationship relative to the housing; and an engaging section as portion of jaw "P" of said locking pliers being mounted relative to a locking portion, as the portion between the jaw "P" and the handle "Q", for selectively being locked relative to the locking portion for positioning an article "N" therebetween; wherein when an article is locked relative to the locking portion and the engaging section of the locking pliers, the distal end of said retaining section as portion near 29 can be rotated relative to the housing to permit a power tool to come into engagement with an article "N" per Figs. 5-6. It should be noted that the Applicant has not clearly and distinctly defined "a locking portion" in the specification or in the drawings of the species.

Re claim 12, Selander discloses a pin 29 mounted on the distal end of 28, said pin including a flat side positioned at a 90° angle relative to a cutting edge of a power tool for preventing disengagement of the locking pliers during a cutting operation.

9. Claims 1-2 and 11-12, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Vail 3,093,023.

Re claim 1, Vail discloses a clamping tool 11 for use with a power tool of conduit cutting comprising: a housing 5, 6, adapted to be mounted on a power tool per Figs. 1-3, said housing including at least one engaging portion 6; a locking pliers 11 having a

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retaining section at 40 with a proximal end at nearby of 41 and a distal end at 39, said proximal end at nearby of 41 being adapted to be selectively mounted on the at least one engaging portion 6 to selectively retain the locking pliers in a movable relationship relative to the housing 5; and an engaging section 37 of said locking pliers being mounted relative to the retaining section for selectively being locked relative to the distal end of the retaining section for positioning an article "C" therebetween; wherein when an article "C" is locked relative to the distal end of the retaining section and the engaging section of the locking pliers, the proximal end at nearby of 41 of said retaining section can be rotated relative to the housing to permit a power tool to come into engagement with an article "C" per Figs. 1-2.

Re claim 2, Vail discloses a cylindrical pin 40 with a fiat side positioned at a 90° angle relative to a cutting edge of cutter 24 of a power tool for preventing disengagement of the locking pliers during a cutting operation.

Re claim 11, Vail discloses a clamping tool 11 for use with a power tool of conduit cutting comprising: a housing 5,6, adapted to be mounted on a power tool, said housing including at least one engaging portion 6; a locking pliers 11 having a retaining section at 40 with a distal end at 39, said distal end being adapted to be selectively mounted on the at least one engaging portion 6 to selectively retain the locking pliers 11 in a movable relationship relative to the housing 5; and an engaging section 37 of said locking pliers being mounted relative to a locking portion 42, 43, for selectively being locked relative to the locking portion for positioning an article "c" therebetween; wherein when an article is locked relative to the locking portion and the engaging section of the

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locking pliers, the distal end at 39 of said retaining section 40 can be rotated relative to the housing 5 to permit a power tool to come into engagement with an article per Figs. 1-2.

Re claim 12, Vail discloses a pin 40 mounted on the distal end as away for proximal end nearby 41, said pin including a flat side positioned at a 90° angle relative to a cutting edge of cutter 24 of a power tool for preventing disengagement of the locking pliers during a cutting operation per Figs. 1-2.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BHARAT C. PATEL whose telephone number is (571)270-3078. The examiner can normally be reached on Monday-Friday, alt. Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 24502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bharat C Patel/  
Examiner, Art Unit 3724  
January 28, 2009.

/Ghassem Alie/  
Primary Examiner, Art Unit 3724